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10/735,670	12/16/2003	Gakushi Aota	8071-1001	2825
466	7590	08/06/2007	EXAMINER	
YOUNG & THOMPSON			ISSAC, ROY P	
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ARLINGTON, VA 22202			1623	
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			08/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,670

Applicant(s)

AOTA, GAKUSHI

Examiner

Roy P. Issac

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 May, 2007 has been entered.

Status of the Application

Claims 1-17 have been amended and claims 18-20 are newly submitted. Currently, claims 1-20 pending.

Rejections Withdrawn

Rejections of claims 1-17 under section 112, second paragraph in regards to the recitations "at most 0.7 μm " and "at least 90vol%" are withdrawn since said phrases are deleted and the term "D₉₀" is inserted.

Rejection of claims 5-15 under section 112, second paragraph in regards to the recitation "cosmetic ingredient" is withdrawn since said term is deleted.

Applicant's arguments, see Page 8, last paragraph to Page 9, second paragraph, filed 5/25/2007, with respect to rejections of claims 16-17 under section 112 first paragraph have been fully considered and are persuasive. The rejection of claims 16 and 17 has been withdrawn.

Art Unit: 1623

Applicants' amendment inserting the recitation "aqueous dispersing agent" to claim 1 will overcome rejections under section 102(b) of claims 1-2, 5-6, 9-10, 13 and 14 over Ser et. al. since Ser et. al. is directed to an anhydrous solid dispersion.

Applicants' amendment inserting the recitation reciting the particular cosmetic products in claim 6, inserting the recitation "to aqueous cosmetic product," and inserting particular polymers and thickeners in claims 11 and 12, and inserting weight percentages for pigments and water in claim 16 overcomes rejection under section 102(b) of claims 5-12 and 16-17 over Goulle et. al.

The following are modified rejections due to applicants amendments to the claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 13 and 20 the only independent claims in the application refers to "at most 0.7 μm " as the dispersed particle size. The lack of a lower limit renders the claim indefinite.

Response to Arguments

Applicant's arguments filed 5/25/2007 with respect to this rejection of claims 1-17 made under 35 U.S.C. § 112 second paragraph, of record in the previous Office Action

Art Unit: 1623

have been fully considered but they are not deemed persuasive to render the claimed invention patentable over the prior art as further discussed below.

Applicants argue that the phrase "a D_{90} of not more than $0.7\mu\text{m}$ " is definite, as one of ordinary skill in the art, in light of the present specification and the terminology used in art would have understood the scope of the claims. However, there is no indication in the specification to show which size above zero is covered by the instant claims. As such, one of skill in the art will not be able to determine the scope of the claim coverage from the limitation "at most $0.7\mu\text{m}$." The rejection under section 112, second paragraph is still deemed proper and is adhered to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 13-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall-Goulle et. al. U.S. Patent No. 6,001,168; Of Record).

Hall-Goulle et. al. claims a pigment dispersion comprising a polymer and a pigment compound in a water free or water-containing solvent with an average particle size of less than $0.5\mu\text{m}$. (Column 12-13, Claim 1; Column 3, lines 32-45). The pigment

Art Unit: 1623

is disclosed as useful in cosmetic compositions. (Column 1, lines 25-30). Water is considered a cosmetic ingredient. The reported particle size of 0.5 μm is well below the 0.7 μm recited in claims herein. Examples 1-6 of the '168 patent discloses preparations with varying pigment ratios. (Columns 11-12). The '168 patent discloses the use of styrenes (30% in 350g of water) which are considered to have dispersant and thickener properties with pigment cakes (39.6g). (Examples 3-6). Various types of surfactants can be used as dispersants, including water-soluble polymers. (Specification, Page 6, lines 5-10). Hall-Goulle describes the use of polymers in water-containing pigment dispersions that has hydrophilic regions. Hall-Goulle further discloses the use of surfactants in the pigment dispersion. (Column 5, lines 10-27). Hall-Goulle further discloses the use of the pigment dispersion as a coloring agent. (Column 7, lines 27-33). The recitation of viscosity as a limitation is considered a functional description of the composition. The composition of Hall-Goulle does not report a viscosity measurement. However, there is nothing in the applicants' specification or Hall-Goulle et. al. showing that the viscosity of the compositions of Hall-Goulle is different from that claimed herein. Hall-Goulle further discloses the use of mixtures of water and water-free organic solvents. Emulsions are mixtures of solvents that do not dissolve in each other. One of ordinary skill in the art will know that mixtures of organic solvents and water will form emulsions. The recitation "forming an aqueous cosmetic product" is considered an intended use of a composition.

Response to Arguments

Applicant's arguments filed 26 October 2006 with respect to this rejection of claims 1-17 made under 35 U.S.C 102(b) of record in the previous Office Action have been fully considered but they are not deemed persuasive to render the claimed invention patentable over the prior art as further discussed below. Applicants argue that Goulle et. al. discloses actual size of particle that is independent from its state in the medium. However, the '168 patent discloses a "pigment dispersion having an average particle size of less than 0.5 micrometers". (Claim 1, Columns 12-13). As such the average size disclosed is considered the dispersed particle size. Applicants further argue that the disclosure of Goulle was based on measurements using a different machine. Even though these two might be different measurements, there is no reason to think that the particle size of Hall-Goulle et. al. do not fall into the claimed range herein. The prior art products appear to have identical or substantially identical properties. Since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

Art Unit: 1623

The following is a new ground of rejection:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-12 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goulle et. al. (Of record) in view of Butler et. al. (Poucher's Perfumes, Cosmetics and Soaps, 2000, 199-216; PTO-892).

The disclosure of Goulle et. al. is discussed above.

Goulle et. al. does not exemplify the use of the pigment dispersion in a cosmetic product or disclose the use of more than 50% water in a composition.

Butler et. al. discloses methods of making mascara and lipstick. Butler discloses mascara compositions wherein water content is over 60%. (Formula XV, Page 201).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pigment dispersion of Goulle et. al. in a cosmetic composition in particular a mascara with a water content of more than 60% since Goulle et. al. suggests the use of pigments of Goulle et. al. in cosmetics and Butler et. al. discloses processes for producing mascara that contains more than 60% water and pigments. Therefore, one of ordinary skill in the art would have reasonably expected that the use of dye dispersions disclosed in Goulle et. al. would have resulted in substantially similar or better effects for cosmetics.

Art Unit: 1623

Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

No claims are allowed. This rejection is made NON-FINAL due to the new/modified grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy P. Issac whose telephone number is 571-272-2674. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

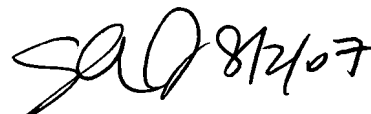
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Application/Control Number: 10/735,670

Page 9

Art Unit: 1623

Roy P. Issac
Patent Examiner
Art Unit 1623

A handwritten signature in black ink, appearing to read 'SAJ 8/2/07'. The signature is stylized and cursive.

S. Anna Jiang, Ph.D.
Supervisory Patent Examiner
Art Unit 1623